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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,003	03/27/2001	Raymond F. Ratcliff III	40017660-0002	2031

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EXAMINER

SHIN, KYUNG H

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/818,003		<b>Applicant(s)</b> RATCLIFF, RAYMOND F.	
	<b>Examiner</b> Kyung H Shin		<b>Art Unit</b> 2143	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/02/01</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responding to application papers dated 3/27/2001.
2. Claims **1-44** are pending. Independent claims are **1, 12, 16, 22, 30, 34, 38** and **42**.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2, 7-9, 12- 19, 21-23, 30, 31, 33-42, 44** are rejected under 35 U.S.C. 102(e) as being unpatentable over **Eldridge et al.** (US Patent No. 6,515,988 B1: Token-based document transactions, Filed on Jul. 17, 1998).

**Regarding Claim 1**, Eldridge discloses a method for sending information to a data processing apparatus for identification of a document having the information using a handheld device capable of communicating with the data processing apparatus, the handheld device having a memory, the method comprising:

providing the document; (see col. 1, lines 28-35)

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capturing the information from the document; (see col. 1, lines 54-64; col. 2, lines 26-28)

storing the captured information in the memory of the handheld device as document data; (see col. 1, lines 50-53)

establishing a communications path between the handheld device and the data processing apparatus; (see col. 4, line 64 - col. 5, line 3)

retrieving the document data from the memory of the handheld device; (see col. 5, lines 23-28) and

sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document. (see col. 1, lines 64-67; col. 3, lines 11-12)

**Regarding Claim 2**, Eldridge discloses the method of claim 1 wherein the document is an electronic document. (see col. 1, lines 32-35; col. 9, lines 24-29)

**Regarding Claim 7**, Eldridge discloses the method of claim 1 wherein the handheld device is a cellular phone. (see col. 5, lines 35-40)

**Regarding Claim 8**, Eldridge discloses the method of claim 1 wherein the handheld device is a personal digital assistant ("PDA"). (see col. 5, lines 23-28)

**Regarding Claim 9**, Eldridge discloses the method of claim 1 wherein the handheld device is a watch. (see col. 1, lines 23-28)

**Regarding Claim 12**, Eldridge discloses in a data processing apparatus, a method for identifying a document for sharing with a recipient, the method comprising:

providing a plurality of reference documents, each reference document having reference data stored in a memory; (see col. 1, lines 28-35)

receiving, from a handheld device, document data associated with one of the reference documents; (see col. 1, lines 54-64; col. 2, lines 26-28)

extracting at least a portion of the received document data as scanning data; (see col. 5, lines 19-23)

retrieving the reference data from the memory; (see col. 1, lines 64-67; col. 3, lines 11-12)

comparing the scanning data with the reference data; and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see col. 2, lines 26-28)

**Regarding Claim 13**, Eldridge discloses the method of claim 12 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 14**, Eldridge discloses the method of claim 12 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 15**, Eldridge discloses the method of claim 12 wherein the scanning data extracted from the received document data includes digital text data identifying a publication date of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 16**, Eldridge discloses in a data processing apparatus, a method for identifying a document and sharing the identified document with a recipient, the data processing apparatus coupled to a data network, the method comprising:

- providing a plurality of reference documents, each reference document having associated reference data stored in a memory; (see col. 1, lines 28-35)

- receiving, from a handheld device in communication with the data processing apparatus, information captured from a source document by the handheld device and address information identifying a receiving address for the recipient; (see col. 1, lines 50-64; col. 2, lines 26-28)

- extracting at least a portion of the captured information as scanning data; (see col. 5, lines 19-23)

- retrieving the reference data from the memory; (see col. 1, lines 64-67; col. 3, lines 11-12)

comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document; (see col. 2, lines 26-28) and

sending, using the address information, the selected document to the receiving address of the recipient. (see col. 5, lines 14-17)

**Regarding Claim 17**, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the source document. (see col. 2, lines 36-39)

**Regarding Claim 18**, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the source document. (see col. 2, lines 36-39)

**Regarding Claim 19**, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a publication date of the source document. (see col. 2, lines 36-39)

**Regarding Claim 21**, Eldridge discloses the method of claim 16 wherein sending the selected document includes:



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sending the selected document to the receiving address via facsimile transmission. (see col. 2, lines 8-10)

**Regarding Claim 22**, Eldridge discloses a method for sharing with a recipient a document having information using a handheld device having a memory and capable of communicating with a data processing apparatus in communication with a data network, the method comprising:

capturing the information from the document using the handheld device; (see col. 2, lines 26-28)

storing the captured information in the memory of the handheld device; (see col. 1, lines 50-53)

providing, to the handheld device, address information identifying a receiving address for the recipient; (see col. 6, lines 48-53)

storing, in the memory of the handheld device, the address information; (see col. 6, lines 48-53)

establishing a communications path between the handheld device and the data processing apparatus; (see col. 4, line 64 – col. 5, line 3)

sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see col. 1, lines 64-67; col. 3, lines 11-12)

receiving, by the data processing apparatus, the captured information and the address information from the handheld device; (see col. 5, lines 23-28)

extracting at least a portion of the captured information as scanning data; (see col. 5, lines 19-23)

providing a plurality of reference documents, each reference document having reference data stored in a reference memory; (see col. 1, lines 28-35)

retrieving the reference data from the reference memory; (see col. 1, lines 64-67; col. 3, lines 11-12)

comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document; (see col. 2, lines 26-28) and

sending, using the address information, the selected document to the receiving address of the recipient. (see col. 5, lines 14-17)

**Regarding Claim 23**, Eldridge discloses the method of claim 22 wherein the document is an electronic document. (see col. 1, lines 32-35; col. 9, lines 24-29)

**Regarding Claim 30**, Eldridge discloses a data processing apparatus for identifying one of a plurality of reference documents for sharing with a recipient in communication with a data network, each reference document having reference data, from information received from a handheld device in communication with the data processing apparatus, the data processing apparatus coupled to the data network, the apparatus comprising:

a memory in which a plurality of instructions are stored; (see col. 5, lines 5-10) and

a processor coupled to the memory (see col. 5, lines 5-10) and coupled to:

- (i) access the reference data in a storage medium, and
- (ii) receive the information from the handheld device, the processor capable of executing the instructions in the memory, execution of the instructions causing a plurality of steps to be performed including:

extracting at least a portion of the information received from the handheld device as scanning data, (see col. 5, lines 19-23)

comparing the scanning data with the reference data, and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see col. 2, lines 26-28)

**Regarding Claim 31**, Eldridge discloses the data processing apparatus of claim 30, execution of the instructions by the processor causing further steps to be performed, namely:

establishing a communications path between the data processing apparatus and the recipient via the data network, (see col. 4, line 64 - col. 5, line 3) and sending, using the address information, the selected document to the receiving address of the recipient via the communications path. (see col. 5, lines 14-17)

**Regarding Claim 33**, Eldridge discloses the method of claim 31 wherein sending the selected document includes:

sending the selected document to the receiving address via facsimile transmission. (see col. 2, lines 8-10)

**Regarding Claim 34**, Eldridge discloses a system for identifying one of a plurality of reference documents, each reference document having associated reference data, for sharing the identified document with a recipient, the system comprising:

- a data processing apparatus in communication with a data network; (see col. 1, lines 28-35) and

- a handheld device having a memory and capable of:

- capturing the information from the document, (see col. 1, lines 50-64; col. 2, lines 26-28)

- storing the captured information in the memory, (see col. 1, lines 50-53)

- storing, in the memory, address information identifying a receiving address for the recipient, (see col. 1, lines 50-64; col. 2, lines 26-28)

- establishing a communications path with the data processing apparatus, (see col. 4, line 64 - col. 5, line 3) and

- sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see col. 1, lines 64-67; col. 3, lines 11-12)

- the data processing apparatus capable of:

- receiving the captured information and the address information from the handheld device, (see col. 1, lines 50-64; col. 3, lines 11-12)

extracting at least a portion of the captured information as scanning data,  
(see col. 5, lines 19-23)

accessing the reference data, (see col. 1, lines 64-67; col. 3, lines 11-12)

comparing the scanning data with the reference data, selecting, when the  
scanning data matches at least a portion of the reference data associated  
with one of the reference documents, the one reference document as the  
identified document, (see col. 2, lines 26-28)

establishing a communications path between the data processing apparatus  
and the recipient via the data network, (see col. 4, lines 64 - col. 5, line 3) and  
sending, using the address information, the selected document to the  
receiving address of the recipient via the communications path. (see col. 5,  
lines 14-17)

**Regarding Claim 35**, Eldridge discloses the method of claim 34 wherein the handheld  
device is a cellular phone. (see col. 5, lines 35-40)

**Regarding Claim 36**, Eldridge discloses the method of claim 34 wherein the handheld  
device is a personal digital assistant ("PDA"). (see col. 5, lines 23-28)

**Regarding Claim 37**, Eldridge discloses the method of claim 34 wherein the handheld  
device is a watch. (see col. 1, lines 23-28)

**Regarding Claim 38**, Eldridge discloses a processor readable storage medium having processor readable program code such that, when executed by a processor in a data processing apparatus, performs a method for identifying one of a plurality of reference documents for sharing with a recipient, each reference document having reference data, from information received by the data processing apparatus from a handheld device in communication with the data processing apparatus, the method comprising:

extracting at least a portion of the information received from the handheld device as scanning data; (see col. 5, lines 19-23)

extracting at least a portion of the information received from the handheld device as address information identifying a receiving address for the recipient; (see col. 1, lines 50-64; col. 2, lines 26-28)

comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document; (see col. 2, lines 26-28) and

sending, using the address information, the selected document to the receiving address of the recipient. (see col. 5, lines 14-17)

**Regarding Claim 39**, Eldridge discloses the method of claim 38 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 40**, Eldridge discloses the method of claim 38 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 41**, Eldridge discloses the method of claim 38 wherein the scanning data extracted from the received document data includes digital text data identifying a publication date of the one reference document. (see col. 2, lines 36-39)

**Regarding Claim 42**, Eldridge discloses a carrier wave having processor readable program code executable by a processor in a data processing apparatus to perform a method for identifying one of a plurality of reference documents for sharing with a recipient, each reference document having reference data, from information received by the data processing apparatus from a handheld device in communication with the data processing apparatus, the method comprising:

extracting at least a portion of the information received from the handheld device as scanning data; (see col. 5, lines 19-23)

extracting at least a portion of the information received from the handheld device as address information identifying a receiving address for the recipient; (see col. 1, lines 50-64; col. 2, lines 26-28)

comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference

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documents, the one reference document as the identified document; (see col. 2, lines 26-28) and

sending, using the address information, the selected document to the receiving address of the recipient. (see col. 5, lines 14-17)

**Regarding Claim 44**, Eldridge discloses the method of claim 42 wherein sending the selected document includes:

sending the selected document to the receiving address via facsimile transmission. (see col. 2, lines 8-10)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3-6, 24-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over by **Eldridge et al.** (US Patent No. 6,515,988) in view of **Hayakawa** (US Patent No. 6,765,559: Page information display method and device and storage medium storing program for displaying page information)



Eldridge discloses an electronic document server with a network accessible repository (see Eldridge col. 9, lines 24-29: "... request for a document held in an electronic repository ... stored on a remote file server 52 (which may be in a different building or in a different country)"). Eldridge does not disclose the capability to access and process specific physical documents such as a newspaper, magazine, or other periodicals publications. However, Hayakawa discloses the capability to access and process specific physical documents such as a newspapers, magazines, or other periodical publications.

**Regarding Claims 3, 24,** Hayakawa discloses The method of claim 1 wherein the document is a physical document. (see Hayakawa col. 1, lines 43-47) It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to include the capability to access and process specific physical documents such as a newspaper, magazine, or other periodical publication. One would have been motivated to substitute the capabilities in Hayakawa in order to extend and enhance the processing capabilities of the document processing system.

**Regarding Claims 4, 25,** Hayakawa discloses The method of claim 3 wherein the physical document is a periodical article. (see Hayakawa col. 1, lines 14-19) Referring to claims 4, 25, claims 4, 25 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 4, 25 are rejected for the same reason and motivation as the claims 3, 24.

**Regarding Claims 5, 26**, Hayakawa discloses the method of claim 3 wherein the physical document is a newspaper article. (see Hayakawa col. 1, lines 14-19) Referring to claims 5, 26, claims 5, 26 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 5, 26 are rejected for the same reason and motivation as the claims 3, 24.

**Regarding Claims 6, 27**, Hayakawa discloses the method of claim 3 wherein the physical document is a magazine article. (see Hayakawa col. 1, lines 14-19) Referring to claims 6, 27, claims 6, 27 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 6, 27 are rejected for the same reason and motivation as the claims 3, 24.

7. **Claims 10, 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over by **Eldridge et al.** (US Patent No. 6,515,988) in view of **Browning** (US Patent No. 6,707,781: Remote information access system which utilizes handheld scanner)

Eldridge discloses a server system with a network accessible repository for electronic documents. (see Eldridge col. 1, lines 23-28: *"This system can include any number workstations, file servers, ... coupled in a network, and a number of portable devices (e.g. handheld or wristwatch computer) carried by users ...."*) Eldridge does not specifically disclose the capability to scan a physical document (generate an image), decode this into a digital data representation and place it into data storage. Eldridge

does not disclose the capability to process a digital document by the attachment of this electronic document to an e-mail message. However, Browning does disclose the capability to scan a physical document (i.e. generate an image), decode it into digital data and place the final digital representation into system storage. Further, Browning discloses the capability to process a electronic digital document and attach it to an e-mail message.

**Regarding Claims 10, 28,** Browning discloses the method of claim 1 wherein: capturing the information includes:

scanning the document to generate scanned information, and converting the scanned information to digital text data; (see Browning col. 1, lines 50-53) and wherein storing the captured information includes storing the digital text data. (see Browning col. 2, lines 16-19)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to scan a physical document (i.e. generate an image), decode it into digital data and place it into storage. One would have been motivated to substitute the capabilities in Browning in order to enhance and integrate the capabilities of processing physical documents in the document server system.

**Regarding Claims 20, 32, 43,** Browning discloses the method of claim 16 wherein sending the selected document includes:

attaching the selected document to an e-mail message, and sending the e-mail message to the receiving address via the data network. (see Browning col. 2, lines 9-15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to process an electronic document by its attachment to an e-mail message before network transmission. One would have been motivated to substitute the capabilities in Browning in order to include and enhance the techniques of electronic messaging within the document management system.

8. **Claims 11, 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over by **Eldridge et al.** (US Patent No. 6,515,988) in view of **Hochendoner** (US Patent No. 6,771,568: Digital audio recorder).

Eldridge discloses a document server with a network accessible repository for electronic documents. (see Eldridge col. 9, lines 24-29: “ ... *request for a document held in an electronic repository ...stored on a remote file server 52 (which may be in a different building or in a different country),*”). Eldridge does not specifically disclose the capability to input an audio analog signal message, decode this message into digital data and its placement into data storage. However, Hochendoner does specifically disclose the capability to input an audio analog signal message, decode this message into audio digital data and its placement into data storage.

**Regarding Claims 11, 29**, Hochendoner discloses the method of claim 1 wherein:  
capturing the information includes:

providing the information as spoken audio, (see Hochendoner col. 3, lines 34-36)  
and converting the spoken audio to a digital audio signal; and wherein storing the  
captured information includes storing the digital audio signal. (see Hochendoner col.  
3, lines 23-26)

It would have been obvious to one of ordinary skill in the art at the time the invention  
was made to modify Eldridge with the capability to input an audio analog signal  
message, decode this message into digital data and its placement into data storage.  
One would have been motivated to substitute the capabilities in Hochendoner for the  
integration of multimedia content into the data processing apparatus in order to fulfill a  
need to receive audio signal from any type of handheld devices.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Kyung H Shin whose telephone number is 703-305-  
0711. The examiner can normally be reached on 9 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, David A Wiley can be reached on 703-308-5221. The fax phone number for  
the organization where this application or proceeding is assigned is 703-872-9306.

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*KHS*

Kyung H Shin  
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Art Unit 2143

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Aug. 20, 2004



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